



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,193	12/21/2001	Laurent Chatelier	PF990042	3992
24498	7590	02/08/2008		
Joseph J. Laks THOMSON LICENSING LLC 2 Independence Way PO BOX 5312 PRINCETON, NJ 08543			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 02/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/019,193

Applicant(s)

CHATELIER ET AL.

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/20/07 have been fully considered but they are not persuasive.

With respect to Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alexander et al (6,177,931)** in view of **Cuccia (6,337,719)** and Claims 2-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alexander et al (6,177,931)** in view of **Cuccia (6,337,719)** as applied to claims 1 and 7 above, and further in view of **Herz et al (5,758,257)**, applicant discusses the claimed invention and the prior arts of record and further argues that the prior arts of record do not teach the claim limitations and that there is no motivation to combine the references (see page 5+ of Applicant's Remarks).

In response, Examiner notes Applicant's arguments, however the Examiner disagrees. With respect to claims 1 and 4-7, **Alexander** discloses systems and methods for recording control interface with TV programs, video, ads and program scheduling information and further discloses managing the broadcast service lists in the TV receiver (TV/PC-10), comprising a central unit (TV/PC-10 Processor), reception unit for receiving and storing broadcast services and services lists, a memory (RAM) containing a program, a memory for storing at least one customized list of services (favorite list, etc.,). **Alexander** teaches that TV/PC-10 Processor updates a list of at least one service available to the receiver and stores at least one customized list (favorite list) of services (col.2, line 62-col.3, line 20, col.7, line 58-col.8, line 12, col.9, line 65-col.10, line 29, line

64-col.12, line 9) and that the Processor uses an application (EPG) in the receiver to trigger a consistency check between the at least one customized listing of services (favorite or Record List) and the updates the listing of the at least one services and further teaches verifying the presence of a service contained in the stored customized list with the received updated list (col.7, line 58-col.8, line 12 and col.11, line 56-col.12, line 9). Alexander is silent as to performing an adjustment or modification of the listing, as not to disrupt the receiver use. However, in the same field of endeavor, **Cuccia**, discloses an apparatus for receiving signals (EPG, etc.) during power-off (stand-by) mode, stores the signals and automatically updates the EPG during any or these modes: stand-by mode, when remote control signals are not being received, just after or before power-on/stand-by, nightly, etc. Hence the 103(a) rejection of the claims is proper, meets all the claim limitations and maintained. With respect to claims 2-3 and 8-10, Alexander as modified by Cuccia is silent as to where when the service contained within the stored customer lists is not in the updated list, deleting the service from the customized list. However, in the same field of endeavor, **Herz** discloses verifying the presence of a service in the at least one stored list which is not in the updated list, and in the case such presence is detected, deleting the service from the stored list and where the deletion of service from the stored list is carried out after a predetermined number of checks reveal the presence of the service in the update list (col.22, line 39-col.23, line 18, line 19-col.24, line 58, col.25, line 45-col.26, line 24, line 51-col.27, line 1+ and col.29, line 6+). Herz provides a subscriber a list of n movies, programs, channels, etc., and monitors the list and maintains the list and updates (deleting/adding

service(s)) the list accordingly, based on a criteria. As to claims 8-10, Alexander as modified by Cuccia, is silent as to a counter, which counts the number of times when a service in the customized list is not in the update list, and an erasing means, which deletes the service from the customized list which is activated when the counter reaches a predetermined value and where the predetermined number is more than one and where the counter counts at least two times before the erasing means deletes the service from the customized list. However, **Herz** further discloses verifying the presence of a service in the at least one stored list which is not in the updated list using a counter to count the number of times when a service in the customized list is not in the update list, and an erasing means, which deletes the service from the customized list which is activated when the counter reaches a predetermined value and where the predetermined number is more than one and where the counter counts at least two times before the erasing means deletes the service from the customized list (col.22, line 39-col.23, line 18, line 19-col.24, line 58, col.25, line 45-col.26, line 24, line 51-col.27, line 1+ and col.29, line 6+). Hence the 103(a) rejection is proper, meets all the claim limitations and maintained.

With respect to Applicant's arguments as to no motivation to combine, as such the combination is not proper, Examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In

this case all reference are in the same field of endeavor, as such combining the teaching of Cuccia with Alexander and the various 10(a) rejection, would be within the knowledge of one of ordinary skill in the art, and appropriate motivation was given. Furthermore it appears Applicant's arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. **See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.1986).** In view of the above, the combination of Alexander and Cuccia for claims 1 and 4-7, and Alexander in view of Cuccia and further in view of Herz for claims 2-3 and 8-10, is proper, meets all the claims limitations, maintained as repeated below. **This Office Action is made FINAL.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alexander et al (6,177,931)** in view of **Cuccia (6,337,719)**

As to claim 1, note the **Alexander** reference figures 1 and 3-10, discloses systems and methods for recording control interface with TV programs, video, ads and program scheduling information and further discloses a method for managing the

broadcast service lists in the TV receiver (TV/PC-10), containing a central unit (TV/PC-10 Processor), reception means for receiving and storing broadcast services and services lists, a memory (RAM) containing a program (col.2, line 62-col.3, line 20), a memory for storing at least one customized list of services, the method comprising the steps of:

Receiving (TV/PC-10) a update of a list of at least one service available to the receiver storing at least one customized list (favorite list) of services (col.2, line 62-col.3, line 20, col.7, line 58-col.8, line 12, col.9, line 65-col.10, line 29, line 64-col.12, line 9)

Triggering (TV/PC-10 Processor) a consistency check between the at least one customized listing of services (favorite or Record List) and the update of the listing of the at least one services where the triggering step is chosen by an application in the receiver, the consistency check comprising: verifying the presence of a service contained in the stored customized list with the received updated list (col.7, line 58-col.8, line 12 and col.11, line 56-col.12, line 9).

Alexander fails to explicitly teach performing the adjustment or modification of the listing, as not to disrupt the receiver use.

However, note the **Cuccia** reference, discloses an apparatus for receiving signals (EPG, etc.) during power-off (stand-by) mode, stores the signals and automatically updates the EPG during any or these modes: stand-by mode, when remote control signals are not being received, just after or before power-on/stand-by, nightly, etc.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Cuccia into the system of Alexander to update the listing at moments which are minimally inconvenient to the user, in order not to disrupt other operations of the processor when the user is actively using the receiver, thereby decreasing the response time in processing events when the receiver is actively being used.

As to claim 4, Alexander further discloses where when it is verified that the service contained in the stored customized lists is in the received updated list comparing whether parameters relative to the present service and parameters stored in the stored customized list corresponding to the present service are similar to the parameters relative to the present service in the updated list, and in case of a difference between the parameters, updating the parameters of the present service in the stored customized list (col.11, line 9-col.12, line 9).

As to claim 6, the claimed "Receiver for a digital TV..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 7, Alexander further discloses where the TV system allows the user to select a service of the customized list and for updating the customized list (col.11, line 9-col.12, line 9).

4. Claims 2-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alexander et al (6,177,931)** in view of **Cuccia (6,337,719)** as applied to claims 1 and 7 above, and further in view of **Herz et al (5,758,257)**

As to claims 2-3, Alexander as modified by Cuccia, fail to explicitly teach where when the service contained within the stored customized lists is not in the updated list, deleting the service from the customized list.

However, **Herz** discloses verifying the presence of a service in the at least one stored list which is not in the updated list, and in the case such presence is detected, deleting the service from the stored list and where the deletion of service from the stored list is carried out after a predetermined number of checks reveal the presence of the service in the update list (col.22, line 39-col.23, line 18, line 19-col.24, line 58, col.25, line 45-col.26, line 24, line 51-col.27, line 1+ and col.29, line 6+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Herz into the system of Alexander as modified by Cuccia to monitor the service(s) stored on the customized list and update the stored customized list accordingly, by deleting outdated or obsolete services stored on the customized list.

As to claims 8-10, Alexander as modified by Cuccia, fail to explicitly teach where a counter counts the number of times when a service in the customized list is not in the update list, and an erasing means, which deletes the service from the customized list which is activated when the counter reaches a predetermined value and where the predetermined number is more than one and where the counter counts at least two times before the erasing means deletes the service from the customized list.

However, **Herz** discloses verifying the presence of a service in the at least one stored list which is not in the updated list using a counter to count the number of times

when a service in the customized list is not in the update list, and an erasing means, which deletes the service from the customized list which is activated when the counter reaches a predetermined value and where the predetermined number is more than one and where the counter counts at least two times before the erasing means deletes the service from the customized list (col.22, line 39-col.23, line 18, line 19-col.24, line 58, col.25, line 45-col.26, line 24, line 51-col.27, line 1+ and col.29, line 6+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Herz into the system of Alexander as modified by Cuccia to monitor on regular basis, the service(s) stored on the customized list and update the stored customized list accordingly, by deleting outdated or obsolete services stored on the customized list, thereby presenting or targeting specific service(s) of interest to the user, based on past history or habits as to services stored on the customized list.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

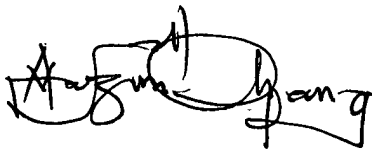
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized, cursive script.

Annan Q. Shang